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In re Application of
DENTON ET AL.
U.S. Application: 10/019,415
PCT Application No.: PCT/US00/17540
International Filing Date: 26 June 2000
Priority Date: 25 June 1999
Attorney's Docket No.: 2458-4042US4
For: METHODS FOR OBTAINING AND USING
HAPLOTYPE DATA

NOTIFICATION

This decision is in response to applicants' filing of five separate sets of national stage application papers for international application PCT/US00/17540.

BACKGROUND

On 26 June 2000, applicants filed international application PCT/US00/17540, which claimed a priority date of 25 June 1999 from provisional application 60/141,521 filed in the United States of America. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 25 January 2001. Accordingly, the thirty-month period for meeting the requirements for entry into the national stage expired at midnight on 26 December 2001.

On 21 December 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic filing fee, a copy of the international application communicated by the International Bureau, and a preliminary amendment canceling claims 1-53, 56-104, 107-155, 157-183. Applicants did not submit an oath or declaration of the inventors (35 U.S.C. 371(c)(4)). This transmittal letter resulted in the above U.S. application number.

On 21 December 2001, applicants filed three additional transmittal letters for entry into the national stage in the United States based upon PCT/US00/17540, each of which was accompanied by, *inter alia*, the requisite basic filing fee, a copy of the international application communicated by the International Bureau, and a preliminary amendment. Applicants did not submit an oath or declaration of the inventors (35 U.S.C. 371(c)(4)) in any of the additional letters. These transmittal letters resulted in the following U.S. application numbers:

- (1) 10/019,242, bearing attorney docket number 2458-4042US2, in which the preliminary amendment cancels claims 9-68, 73-119, and 125-183;
- (2) 10/019,243, bearing attorney docket number 2458-4042US3, in which the preliminary amendment cancels claims 1-12, 22-73, 79-124, and 130-183; and
- (3) 10/019,342, bearing attorney docket number 2458-4042US5, in which the preliminary amendment cancels claims 1-58, 69-109, 120-160, and 171-183.

On 26 December 2001, applicants filed an additional transmittal letter for entry into the national stage in the United States based upon PCT/US00/17540 which was accompanied by, *inter alia*, the requisite basic filing fee, a copy of the international application communicated by the International Bureau, and a preliminary amendment. Applicants did not submit an oath or declaration of the inventors (35 U.S.C. 371(c)(4)). This transmittal letter resulted in the following U.S. application number:

(1) 10/019,593, bearing attorney docket number 2458-4042US6, in which the preliminary amendment cancels claims 1-183 and adds new claims 184 and 185.

On 19 March 2002, the United States Designated/Elected Office (PTO) mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) (Form PCT/DO/EO/905) for U.S. application number 10/019,415 indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) was required as well as the surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). Applicants were given a TWO (2) MONTH period from the mail date of the Notification to properly respond, with extensions of time obtainable under 37 C.F.R. 1.136(a).

DISCUSSION

As indicated in the above recited facts, applicants filed five sets of papers to enter the national stage for PCT/US00/17540. The end result for an international application designating the United States of America is a single U.S. national stage application. Application Number 10/019,415 is the National stage application for International application PCT/US00/17540. Therefore, the submission of five sets of national stage papers to enter the United States of America is improper.

Applicants may provide petitions under 37 CFR 1.182 to convert each or any of the additional sets of papers filed 21 December 2001 and 26 December 2001 to respective 37 CFR 1.111(a) applications. Else, the four additional sets of papers or any additional set in which a petition under 37 CFR 1.182 is not provided filed on 21 December 2001 and 26 December 2001 will be placed in the file of application number 10/019,415, except for duplicate copies thereof, and examination shall proceed using the submission accorded application number 10/019,415 which bears attorney docket number 2458-4042US4 and the preliminary amendment canceling claims 1-53, 56-104, 107-155, and 157-183. The preliminary amendments directed to any of the four additional sets of papers filed 21 December 2001 and 26 December 2001 in which a petition under 37 CFR 1.182 is not provided will not be entered.

CONCLUSION

For the reasons above, submission of five separate sets of papers to enter the National Stage is improper.

A proper response to this notification must be filed within TWO (2) MONTHS from the mail date of this decision. A proper response includes filing a petition under 37 CFR 1.182, with the appropriate petition fee, for each or any of the additional sets of papers filed 21 December 2001 and 26 December 2001 which applicants intends to convert to 37 CFR 1.111(a) applications or respective

statements for any of the four additional sets of papers filed 21 December 2001 and 26 December 2001 which applicants do not intend to convert to 37 CFR 1.111(a) applications. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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